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# UNITED STATES PATENT AND TRADEMARK OFFICE

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| 09/684,937 | 10/06/2000 | Joel E. Short | NOMI 0119 PUS | 2116 |

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| EXAMINER |
|---|
| HA, YVONNE QUY M |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2664 | |

DATE MAILED: 04/22/2004          11

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *13 February 2004*.

2a)☐ This action is **FINAL**.    2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-20* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

## DETAILED ACTION

### *Response to Amendment*

1.    The amendment dated 2/13/2004 has been entered. Claims 1-20 are pending.

### *Claim Rejections - 35 USC § 102*

2.    The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed
> in the United States before the invention by the applicant for patent or (2) a patent granted on an application for
> patent by another filed in the United States before the invention by the applicant for patent, except that an
> international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this
> subsection of an application filed in the United States only if the international application designated the United
> States and was published under Article 21(2) of such treaty in the English language.

3.    Claims 1-3, 5-9, 11-17, 19, 20, are rejected under 35 U.S.C. 102(e) as being anticipated

by Bronstein et al. (US Patent 5,910,954).

Referring to claims 1 and 19, Bronstein discloses a method for providing connectivity to

a second local area network for a user device configured for a first local area network (col. 2,

lines 52-67;figure 3c, i.e. network switch, which connects to many legacy LANS; col. 8, lines

59-63), the method comprising: intercepting packets transmitted by the user device intended for a

device on the first local area network to automatically determine network settings of the user

device (col. 6, lines 1-24); modifying incompatible packets transmitted by the user device to

make the packets compatible with the second local area network based on the network settings of

the user device and the second local area network (col. 6, lines 51-67; col. 8 lines 19-25).

Referring to claims 2 and 15, Bronstein discloses all aspects of the claimed invention and

further teaches the step of intercepting packets comprises receiving and processing packets,

which would otherwise be dropped by devices on the second local area network due to
incompatible network settings (col. 6, lines 1-24, 51-67).

Referring to claim 3, Bronstein discloses all aspects of the claimed invention and further
teaches automatically determining the network settings of the second local area network based
on packets transmitted over the second local area network (col. 6, lines 1-24, 51-67).

Referring to claims 5, 17, and 20, Bronstein discloses all aspects of the claimed invention
and further teaches the step of intercepting packets comprises: intercepting an Address
Resolution Protocol (ARP) message transmitted by the user device having a network address of a
device on the first local area network (col. 6, lines 1-24, includes MAC address); and replying to
the ARP message with a Media Access Control (MAC) address of a device on the second local
area network (col. 6, lines 1-24, 51-67).

Referring to claims 6 and 16, Bronstein discloses all aspects of the claimed invention and
further teaches the step of intercepting packets comprises operating in a promiscuous mode to
receive and process all packets transmitted by the user device (col. 6, lines 1-24, 51-67; col. 8,
lines 39-53).

Referring to claim 7, Bronstein discloses all aspects of the claimed invention and further
teaches the step of modifying packets comprises replacing a source address with a router address
where the router address is automatically determined based on the network settings of the second
local area network (col. 6, lines 1-24, 51-67).

Referring to claim 8, Bronstein discloses all aspects of the claimed invention and further
teaches the step of modifying packets comprises replacing a source address within a packet
header (col. 6, lines 1-8, 30-67; figure 6).

Referring to claim 9, Bronstein t discloses all aspects of the claimed invention and further

teaches the step of modifying packets comprises replacing a source address within contents of

the packet (col. 6, lines 1-8, 30-67; figure 6).

Referring to claim 11, Bronstein providing access to a network utilizing private IP

addresses (i.e. internal address; col. 6, lines 53-56) for a user device having an incompatible

private IP address (col. 2, lines 52-67;figure 3c, i.e. network switch, which connects to many

legacy LANS; col. 8, lines 59-63), the method comprising: intercepting data transmitted by the

user device containing the incompatible private IP address (col. 6, lines 1-24); modifying the

data using a private IP address compatible with the network private IP addresses (col. 6, lines 51-

67; col. 8 lines 19-25); transmitting the modified data on the network (col. 6, lines 59-67; col. 7,

lines 1-6).

Referring to claim 12, Bronstein discloses all aspects of the claimed invention further

teaches connecting a translator to the network (figure 5) to perform the steps of intercepting the

data transmitted by the user device (col. 6, lines 1-24), modifying the data (col. 6, lines 51-67;

col. 8 lines 19-25), and transmitting the data (col. 6, lines 59-67; col. 7, lines 1-6).

Referring to claim 13 and 14, Bronstein discloses all aspects of the claimed invention and

further teaches the step of connecting comprises connecting the translator between the user

device and the network (figures 5 of 1-3).

### Claim Rejections - 35 USC § 103

4.      The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5.      Claims 4, 10, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Bronstein et al. (US Patent 5,910,954) in view of Verthein et al. (US Patent 6,249,527).

Referring to claim 4, Bronstein discloses all aspects of the claimed invention but failed to

teach automatically determining the network settings of the second local area network by

transmitting a Dynamic Host Control Protocol (DHCP) packet over the second local area

network. However, Verthein discloses DHCP automatically assigning IP configuration to remote

workstations on LAN, (col. 9, lines 31-43). At the time of the invention, it would have been

obvious to a person of ordinary skill in the art to combine the teaching of Bronstein emulating

legacy LAN workstations, switches and ATM with Verthein remote access system of using

DHCP protocol. DHCP is a network protocol that enables a DHCP server to automatically assign

an IP address to an individual computer or network device. DHCP assigns a number dynamically

from a defined range of numbers configured for a given network. DHCP assigns an IP address

when a system is started. This would eliminate the need for manually configuring each

workstation.

Referring to claims 10 and 18, Bronstein discloses all aspects of the claimed invention

but failed to teach the intercepting a Dynamic Host Control Protocol (DHCP) packet transmitted

by the user device; determining whether a DHCP server is available on the second local area

network; and replying to the DHCP packet to provide configuration settings based on network

settings of the second local area network. However, Verthein discloses DHCP automatically

assigning IP configuration to remote workstations on LAN (col. 9, lines 31-43); direct remote

users to the appropriate server (col. 9, lines 5-29); assemble into packets compatible with the

operating system of computing platform (col. 9, lines 50-67). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the teaching of Bronstein emulating legacy LAN workstations, switches and ATM with Verthein remote access system of using DHCP protocol. DHCP is a network protocol that enables a DHCP server to automatically assign an IP address to an individual computer or network device. DHCP assigns a number dynamically from a defined range of numbers configured for a given network. DHCP assigns an IP address when a system is started. This would eliminate the need for manually configuring each workstation. Using the remote access by DHCP protocol will produce quicker response times for many calls, decreases network traffic, and allows the network to support more remote users and applications processing.

### Response to Arguments

6.      Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

### Conclusion

7.      The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Vincent et al. (US Patent 6,055,243) discloses associated method for re-engineering a telecommunications support with translators
- Ford (US Patent 6,463,051) discloses IP calling system
- Terry (US Patent 6,061,356) discloses switching routable frames between disparate media

Any inquiry concerning this communication or earlier communications from the
examiner should be directed to Yvonne Q. Ha whose telephone number is 703-305-8392. The
examiner can normally be reached on Monday-Friday 7a.m.-4p.m. Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's
supervisor, Ajit Patel can be reached on 703-308-5347. The fax phone number for the
organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent
Application Information Retrieval (PAIR) system. Status information for published applications
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system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


YQH

Ajit Patel
Primary Examiner